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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THANOS KARRAS,
GREG ANGST, and MILTON SILVA-CRAIG

Appeal 2007-3166
Application 09/681,306
Technology Center 3600

Decided: June 27, 2008

Before TERRY J. OWENS, HUBERT C. LORIN, and
DAVID B. WALKER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

The Appellants filed a Request for Rehearing under 37 C.F.R. § 41.52 (filed Apr. 30, 2008) of the Decision on Appeal (mailed Mar. 31, 2008).

In the Decision on Appeal, the Board affirmed rejections of claims 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by Wood ‘035; claims 1, 4, 5, 7-9, 11, 13, 14, 33, and 34 under 35 U.S.C. § 103(a) as unpatentable over Evans and Wood ‘186; claim 3 under 35 U.S.C. § 103(a) as unpatentable over Evans, Wood ‘186, and Wood ‘035; claims 6, 12, and 16 under 35 U.S.C. § 103(a) as unpatentable over Evans, Wood ‘186, and Rothschild; claims 17, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Applicants’ Background and Rothschild; claim 23 under 35 U.S.C. § 103(a) as unpatentable over Wood ‘035 and Evans; claims 24-32, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Evans, Rothschild, and Wood ‘035.

A central question in the Appeal was whether the prior art disclosed or suggested a “mobile facility,” per the claims. Wood ‘035, for example, describes a “cart.” The Board saw no difference between the “cart” of Wood ‘035 and the “facility” recited in the claims.

We see no difference between a “facility,” as the term is used in the claim, and the “cart” described in Wood ‘035. The Specification provides no definition for the claim term “facility.” Accordingly, it is given the ordinary and customary meaning, which is “[s]omething that facilitates an action or process.” FF 3.¹¹ Giving the claim its broadest reasonable construction in light of the Specification as it would be interpreted

¹ “3. The ordinary and customary meaning of “facility” is: “3. *often* facilities. Something that facilitates an action or process. 4. Something created to serve a particular function <a new mental health *facility*>”. (See Webster’s II New Riverside University Dictionary (1984).)(Entry for “facility.”)” (Decision 5.)

by one of ordinary skill in the art, it describes a system comprising a mobile “something that facilitates an action or process” adapted to be used at a plurality of locations. The Wood ‘035 “cart” reads on that element of the claimed system.

(Decision 9.)

In the Request for Rehearing, the Appellants argue that the Board misapprehended the meaning of the claim term “facility” and as a result should reconsider the sustainability of the Examiner’s Rejections. (Request 2.)

Specifically, in the Request for Rehearing, the Appellants argued that the Board was incorrect to state in the Decision that “[t]he Specification does not provide a definition for the [claim term] ‘facility’” (Finding of Fact 2; Decision 5) such that it would exclude carts of the type disclosed in Wood ‘035. (Request 2.) According to the Appellants, the Specification defines the “mobile facility” as a mobile version of a healthcare facility.

According to the Appellants, the claimed “facility” excludes carts because “[t]he mobile facility is defined in the specification as a vehicle, such as a truck or van, that includes imaging equipment, and the Applicant’s specification supports a construction of a mobile imaging unit as a mobile facility or vehicle” (Request 3). As evidence that the Specification defines the claimed “facility” as a truck or van and not a cart, the Appellants draw our attention to a passage from pages 1-2 of the Specification, reproduced below:

Many healthcare facilities, such as hospitals and clinics, employ mobile imaging units to facilitate medical examination of patients. Mobile

imaging units may include equipment for MR (magnetic resonance), CT (computerized tomography), and the like, to facilitate medical examination of patients. Because hospitals and clinics may not have adequate facilities or funding to handle all patients and examinations, hospitals and clinics may hire or purchase mobile imaging units to help perform medical diagnostic examinations, for example MR and CT imaging. The use of mobile imaging units helps to reduce patient overflow problems by providing healthcare facilities with additional resources for patient examination. Additionally, the use of mobile imaging units may provide access to technologically advanced imaging solutions on a cost-effective basis.

A typical mobile imaging unit may be scheduled among multiple healthcare facilities. Mobile imaging units (typically large trucks or vans) are usually positioned outside the healthcare facility. A patient may be sent from the hospital or clinic to the mobile unit. An image may be taken of a patient (such as a MR or CT image) in the mobile unit. Currently, the patient image is manually processed in the mobile unit. Commonly, the image is either printed on film or stored on media such as a floppy disk, CD-ROM, and the like. The stored image is typically manually transported (often called “sneaker net” in the art) from the mobile imaging unit to the hospital or clinic where the image may be further processed or stored. Alternatively, some mobile imaging units and hospitals transmit images from a mobile unit to a hospital or clinic via a cable network connection (such as an Ethernet connection in the parking lot).

(Request 4.) The Appellants take the position that this passage from the Specification defines mobile imaging units as typically large trucks and vans, not carts. “A large truck or van, or their equivalent, would not include a wheeled cart. One cannot enter a wheeled cart [as per Wood ‘035] as one can a truck or van, and one cannot move from location to location as one can in a truck or van.” (Request 4.)

According to the Appellants, the claimed “facility” excludes carts because the Specification “further defines the contents of the [claimed] mobile imaging unit” (Request 4) in such a way that it would preclude using a wheeled cart. As evidence, the Appellants draw our attention to passages in the Specification at pages 8 and 10. (See Request 4 and 5.)

According to the Appellants, the Specification “draws many parallels between the mobile imaging unit and the healthcare facility, except that the mobile imaging unit may move geographically and may, for example, be positioned outside of one healthcare facility on one day and outside another healthcare facility on another day. Clearly, this is not the capability of a wheeled cart.” (Request 5.) The Appellants also point out that the Specification (relying on pages 10-11; Request 6)

emphasizes the relationship between the mobile imaging unit and the healthcare facility and the view of the mobile imaging unit as a mobile facility usable apart from and along with the healthcare facility, as opposed to an imaging scanner for use as a component within the healthcare facility [as Wood ‘035 describes its cart as being].

(Request 6.) “The equipment included in the mobile imaging unit could definitely include the wheeled ultrasound cart of the Wood ‘035 patent, but the mobile imaging unit as described in the present application is clearly different and patentably distinct from the wheeled ultrasound cart of Wood ‘035.” (Request 7.)

The Appellants conclude that the “meaning of the term ‘mobile imaging unit’ is clear in the specification to a person skilled in the art, and the Examiner should fairly rely on that meaning in interpreting the claims in view of the prior art.” (Request 8.)

The Appellants also observe that the Board relied on the third definition for the term “facility” given in *Webster’s II New Riverside University Dictionary* (1984) and not the fourth definition. (See Decision 5.) (Request 9.) The Appellants point out that the fourth definition is “[s]omething created to serve a particular function <a new mental health facility>”. (Request 9.) The Appellants cite other dictionaries which similarly define “facility” in the context of buildings such as hospitals. According to the Appellants, “[t]hese definitions all use a hospital and/or other building as an example in the definition.” (Request 9.) According to the Appellants,

a cart on wheels is not something that can be entered or visited like a transportation facility, an educational facility, a research facility, or a mobile imaging facility, which would reasonably be viewed to fit this definition in the eyes of one of ordinary skill in the art.

(Request 9.)

Finally, the Appellants argue that “through amendment and argument in the prosecution history, has disclaimed such a claim scope as would cover a cart on wheels rather than a facility that is capable of being moved.” (Request 9-10.)

We have reviewed the Appellants’ arguments. We disagree that we have misapprehended the meaning of the claim term “facility.”

We stated in the decision that the Specification provides no definition for “facility.” We see nothing in the Request which would cause us to change that assessment.

There can be no dispute that there is no explicit definition in the Specification for the term “facility” because there is none. The question is whether the Specification describes the claimed mobile facility in such a manner that one of ordinary skill would interpret the claim term “facility” to mean something more than a cart. The answer to that question is “no.”

We are mindful that “[t]he Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’ *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). However, “[t]he problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.” *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

The Appellants argue that, in light of the Specification, the claim term “facility” means, implicitly, something more than a cart. However, there is nothing in the Specification which would lead one of ordinary skill in the art to interpret the term “facility” as confined to a set of things that would exclude carts of the type described in Wood ‘035. Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480, (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

The Appellants direct our attention to the Specification where trucks or vans are mentioned as examples of mobile facilities. But nowhere does the Specification restrict facilities to trucks and vans. The Appellants direct our attention to the Specification where various possible apparatuses are described as being able to be transported by the mobile facilities. Yet, the Specification is quite clear that there is no restriction as to which equipment the mobile facility must be capable of transporting. The Appellants also direct our attention to passages in the Specification where, according to Appellants, the Specification draws parallels between the mobile imaging

unit and a healthcare facility such as a hospital. Again, the Specification is clear: while the mobile facility of the invention may be viewed as providing services of, for example, a hospital, it is not restricted to being a substitute for such a business.

We have carefully reviewed the Specification and find no disclosure that would lead one of ordinary skill in the art to interpret the claim term “facility” to exclude a cart. To construe the claim term as limited to a truck or van with equipment as one would expect in, for example, a hospital, would be to read limitations from the Specification into the claim. It is improper to read limitations from examples given in the specification into the claims unless they are otherwise required by the claims. *See Constant v. Advanced Micro-Devices, Inc.* 848 F.2d 1560, 1571 (Fed. Cir. 1988). In that regard, claim 1, for example, simply requires “a mobile imaging unit for generating medical data storable in a data center, wherein said mobile imaging unit is a mobile facility adapted to be used at a plurality of locations.” Nothing in the claim requires the facility of the claimed invention to be of the size and mobility of a van or truck, or the capacity to hold equipment such as in a hospital. The passages in the Specification that the Appellants have cited to show the contrary, in fact suggest the Appellants did not intend to limit the scope of the term “facility.”

We note that the Appellants have emphasized that one of ordinary skill in the art would understand the Appellants to have used the term “facility” to convey something on the order of a building, albeit one that is mobile. However, the Appellants have not presented any evidence that one of ordinary skill would have interpreted the term “facility” in the manner the

Appellants have advocated. There is no evidence in the record as to how the claims would be interpreted by one of ordinary skill in the art. We find no evidence supporting the Appellants' contentions elsewhere in the record. *See generally, In re Glass*, 474 F.2d 1015, 1019 (CCPA 1973). The Appellants' attorney's arguments do not take the place of evidence in the record. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977), *cert. denied*, 434 US 854 (1977), and *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965).

We note the Appellants' reliance on a different dictionary meaning for "facility" than the one the Board used to construe the term "facility." The definition the Appellants would have the Board apply, however, does not change the ordinary and customary meaning of the term "facility." The definition the Appellants support does not restrict the term "facility" to a building but rather cites hospitals and/or other buildings as examples.

We are also not persuaded by the argument that the prosecution history evidences that the Appellants have disclaimed the cart of Wood '035 from the scope of the facilities covered by the claimed invention. Notwithstanding that we do not understand to what in the prosecution history the Appellants are referring as evidence, the process of examination is a process whereby the applicant is given an opportunity to precisely define their invention. That is an applicant's burden. *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). The claims define that which Appellants regard to be their invention. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). If the Appellants intended to restrict the scope of the claims to exclude the Wood

‘035 cart, the Appellants had the opportunity to do so. As the claims are currently drafted, their broadest reasonable construction in light of the Specification as they would be interpreted by one of ordinary skill in the art is such that they encompass a cart like the one Wood ‘035 describes.

We have considered the Request for Rehearing. We find that we did not misapprehend the construction of the claim term “facility.” Accordingly, the Appellants’ request to reconsider affirming the rejections of claims 1, 3-9, 11-14, 16, 17, and 19-36, on the grounds that the claim term “facility” excludes carts of the type described in Wood ‘035, is denied.

CONCLUSION

Appellants’ arguments have been considered.

We do not find them persuasive as to error in affirming the rejections of claims 21 and 22 under 35 U.S.C. § 102(b) as being anticipated by Wood ‘035; claims 1, 4, 5, 7-9, 11, 13, 14, 33, and 34 under 35 U.S.C. § 103(a) as unpatentable over Evans and Wood ‘186; claim 3 under 35 U.S.C. § 103(a) as unpatentable over Evans, Wood ‘186, and Wood ‘035; claims 6, 12, and 16 under 35 U.S.C. § 103(a) as unpatentable over Evans, Wood ‘186, and Rothschild; claims 17, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Applicants’ Background and Rothschild; claim 23 under 35 U.S.C. § 103(a) as unpatentable over Wood ‘035 and Evans; claims 24-32, 35, and 36 under 35 U.S.C. § 103(a) as unpatentable over Evans, Rothschild, and Wood ‘035.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (2007).

Appeal 2007-3166
Application 09/681,306

DENIED

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